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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/755,991

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Christopher S. Kade

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02/25/2009

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EXAMINER

PAULS, JOHN A

ART UNIT

PAPER NUMBER

4114

MAIL DATE

DELIVERY MODE

02/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/755,991	Applicant(s) KADE, CHRISTOPHER S.	
	Examiner JOHN A. PAULS	Art Unit 4114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>13 January, 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 13 January, 2004
2. Claims 1 - 23 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on 13 January, 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Specification

4. The disclosure is objected to because of the following informalities: The disclosure recites a "save button" relative to figure 6 (see page 9), however, Figure 6 does not show this feature. For purposes of this examination, Examiner assumes that the "Apply" button performs this function. Appropriate correction is required.

Claim Objections

5. Claim 19 is objected to because of the following informalities: Claim 19 recites "*procedure which was performed displays allows editing...*". The phrase does not make sense as it contains two verbs (*displays allows*). For purposes of this examination, Examiner will assume that the word "*displays*" be removed. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 - 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 10, 17 – 20 and 21 recite means for, however, the specification does not disclose specific structure or acts as required by USC 112 6th paragraph. Therefore the scope of the claims is not clear.
8. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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11. Claim 1 – 17 and 19 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm (US 5,319,543 A) and in further view of Buchanan et al. (US 5,267,155 A).

CLAIM 1

Wilhelm as shown discloses the following limitations:

- *displaying a list of patient cases for which operative notes need to be created;* (see at least Wilhelm column 2 line 16 – 21)
- *displaying a procedure performed for one of the patient cases;* (see at least Wilhelm column 6 line 40 – 46)

Wilhelm as shown discloses the limitations shown above. Wilhelm does not disclose the following limitations but Buchanan does:

- *displaying a list of sections for an operative note;* (see at least Buchanan column 2 line 57 to column 3 line 2);
- *text that comprises a selected section from of the list of sections of the operative note;* (see at least Buchanan column 1 line 17 – 24;
- *inserting predetermined text into the operative note having indicia indicating where the surgeon must modify the operative note to include information specific to the patient upon which the surgical procedure has been performed;* (see at least Buchanan column 2 line 1 – 4 and line 41 – 51);
- *providing means for successively identifying the indicia where text must be inserted into the operative note;* (see at least Buchanan column 4 line 4 – 42; column 2 line 1 – 4 and column 5 line 13 – 26).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the medical records tracking system of Wilhelm with the medical document generation system of Buchanan because the use of a system that generates documents with pre-determined templates will provide cost savings and efficiency and improve the reporting to federal agencies.

CLAIMS 2 and 20

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm also discloses the following limitations:

- *displaying a list of surgeons authorized to prepare operative notes;* (see at least Wilhelm column 7 line 32 – 46);
- *the step of displaying a list of patient cases for which operative notes need to be created is performed in response to the selection of a particular surgeon from the list of surgeons authorized to prepare operative note;* (see at least Wilhelm column 7 line 32 – 46 and column 6 line 7 - 13).

CLAIMS 3, 11 and 21

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm also discloses the following limitations:

- *information comprising the list of patient cases for which operative notes need to be created and the procedure performed for the patient case are obtained from a database created by a separate software package; (see at least Wilhelm column 2 line 1 – 21).*

CLAIMS 4 and 12

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm also discloses the following limitations:

- *accessing a database to determine all procedures recently performed; (see at least Wilhelm column 7 line 17 – 21 and column 6 line 40 - 46);*
- *determining whether an operative note has already been completed for that patient case; (see at least Wilhelm column 7 line 37 – 46).*

CLAIMS 5 and 13

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm does not disclose the following limitations but Buchanan does:

- *text unique to the particular surgeon and the procedure performed for the patient case; (see at least Buchanan column 9 line 66 to column 10 line 6).*

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the medical records tracking system of Wilhelm with the medical document generation system of Buchanan because the use of a system that generates documents with pre-determined templates that are customized to a surgeon will provide cost savings and efficiency and improve the reporting to federal agencies.

CLAIMS 6 and 14

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm does not disclose the following limitations but Buchanan does:

- *only one section selected from the list of sections of the operative note is displayed at a time; (see at least Buchanan column 2 line 57 to column 3 line 2 and column 5 line 13 – 26).*

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the medical records tracking system of Wilhelm with the medical document generation system of Buchanan because displaying only one section of the document at a time will provide a methodological approach to document generation and will reduce errors.

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CLAIMS 7 and 15

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm does not disclose the following limitations but Buchanan does:

- *selecting the predetermined text to be inserted from a list of different predetermined texts; (see at least Buchanan column 5 line 13 – 24).*

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the medical records tracking system of Wilhelm with the medical document generation system of Buchanan because the use of a system that generates documents with pre-determined templates will provide cost savings and efficiency and improve the reporting to federal agencies.

CLAIM 8

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm also discloses the following limitations:

- *allowing the surgeon to select and modify the procedure performed in the patient case; (see at least Wilhelm column 6 line 40 – 46 and column 5 line 50 - 54).*

CLAIMS 9, 16 and 23

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm also discloses the following limitations:

- *confirming the identity of the surgeon; (see at least Wilhelm column 4 line 60 to column 5 line 7 and column 10 line 43 – 58)*
- *displaying a list of patient cases associated with the surgeon for which operative notes need to be created; (see at least Wilhelm column 6 line 7 – 13 and column 10 line 43 – 58)*

CLAIM 10

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm also discloses the following limitations:

- *displaying a list of surgeons authorized to prepare operative notes; (see at least Wilhelm column 7 line 32 – 46);*
- *displaying a list of patient cases for which operative notes need to be created in response to the selection of a particular surgeon from the list of surgeons authorized to prepare operative notes; (see at least Wilhelm column 7 line 32 – 46 and column 6 line 7 - 13)*
- *displaying a procedure performed for the patient case; (see at least Wilhelm column 6 line 40 – 46).*

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm does not disclose the following limitations but Buchanan does:

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- *displaying a list of sections for an operative note and; (see at least Buchanan column 2 line 57 to column 3 line 2);*
 - *text that comprises a selected section from of the list of sections of the operative note; (see at least Buchanan column 1 line 17 – 24;*
- *providing means for the surgeon to select a section of the operative note to view that section of the operative note; (see at least Buchanan column 2 line 57 to column 3 line 2);*
- *inserting predetermined text into the operative note having indicia indicating where text must be inserted into the predetermined text to customize the operative note to the patient upon which the surgical procedure has been performed; (see at least Buchanan column 2 line 1 – 4 and line 41 – 51);*
- *providing means for successively identifying the indicia where text must be inserted into the operative note; (see at least Buchanan column 4 line 4 – 42; column 2 line 1 – 4 and column 5 line 13 – 26).*

Examiner notes that Buchanan discloses a system and method that allows a surgeon to select a particular template and then progress through each section of the template (i.e. option text variable location) to complete the document.

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the medical records tracking system of Wilhelm with the medical document generation system of Buchanan because the use of a system that generates documents with pre-determined templates will provide cost savings and efficiency and improve the reporting to federal agencies.

CLAIM 17

Wilhelm as shown discloses the limitations shown above. Wilhelm also discloses the following limitations:

- *means for displaying a list of patient cases for which operative notes need to be created; (see at least Wilhelm column 2 line 1 – 12; column 3 line 49 to column 4 line 8 and column 2 line 16 – 21);*
- *means for selecting a patient case from the list of patient cases; (see at least Wilhelm column 2 line 1 – 12; column 3 line 49 to column 4 line 8 and column 6 line 7 – 13).*

Wilhelm as shown discloses the limitations shown above. Wilhelm does not disclose the following limitations but Buchanan does:

- *a database of predetermined text containing operative notes for a plurality of surgeons and a plurality of procedures, the database comprising a plurality of records, each record comprising a separate operative note for a particular procedure and having at least one surgeon associated with each operative note; (see at least Buchanan column 1 line 17 – 24 and column 2 line 1 – 13);*

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- *each operative note comprises indicia for indicating where the operative note must be modified to customize the operative note to a particular patient upon which the procedure was performed; (see at least Buchanan column 4 line 4 – 42 and column 2 line 1 – 4 and line 41 – 51);*
- *means for selecting a particular operative note from the database of operative notes; (see at least Buchanan column 4 line 4 – 42 and column 5 line 13 – 17);*
- *means for successively directing the surgeon to the indicia of the operative note indicating where the operative note must be modified; (see at least Buchanan column 4 line 4 – 42; column 2 line 1 – 4 and column 5 line 13 – 26);*
- *means for editing the selected operative note to insert text into the predetermined text to customize the operative note to the patient upon which the procedure was performed; (see at least Buchanan column 4 line 4 – 42 and column 9 line 66 to column 10 line 6).*

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the medical records tracking system of Wilhelm with the medical document generation system of Buchanan because the use of a system that generates documents with pre-determined templates will provide cost savings and efficiency and improve the reporting to federal agencies.

CLAIM 19

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm does not disclose the following limitations but Buchanan does:

- *means for displaying a list of sections for an operative note; (see at least Buchanan column 4 line 4 – 42 and column 2 line 57 to column 3 line 2);*
- *means for editing the selected operative note to insert text into the predetermined text to customize the operative note to the patient upon which the procedure was performed displays allows editing of only a section from the list of sections that has been selected from the list; (see at least Buchanan column 4 line 4 – 42 and column 5 line 13 – 26).*

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the medical records tracking system of Wilhelm with the medical document generation system of Buchanan because the use of a system that generates documents with pre-determined templates will provide cost savings and efficiency and improve the reporting to federal agencies.

CLAIM 22

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm does not disclose the following limitations but Buchanan does:

- *means for selecting a particular operative note from the database of operative notes is performed manually by the surgeon by selecting an operative note from a list of operative notes; (see at least Buchanan column 4 line 4 – 42 and column 2 line 13 – 14).*

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It would be obvious to one of ordinary skill in the art at the time of the invention to modify the medical records tracking system of Wilhelm with the medical document generation system of Buchanan because the use of a system that generates documents with pre-determined templates will provide cost savings and efficiency and improve the reporting to federal agencies.

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm (US 5,319,543 A) and in further view of Buchanan et al. (US 5,267,155 A) and in further view of Miller et al. (US 5,446,653 A)

CLAIM 18

The combination of Wilhelm/Buchanan as shown discloses the limitations shown above. Wilhelm/Buchanan does not disclose the following limitations but Miller does:

- *means for selecting a particular operative note from the database of operative notes is performed automatically based upon the surgeon performing the procedure and the procedure performed;* (see at least Miller column 4 line 22 – 39).

Examiner notes the Miller discloses that “any type of document can be generated”. Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to modify the medical records tracking system of Wilhelm/Buchanan with the rule-based document generation system of Miller because identifying specific documents in a database based on a particular data element (i.e. medical procedure code) will provide cost savings and efficiency and improve the reporting to federal agencies.

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CONCLUSION

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **John A. Pauls** whose telephone number is **571-270-5557**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JAMES A. REAGAN** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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or faxed to **571-273-8300**.

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Date: 9 February, 2009

/JOHN A. PAULS/

Examiner, Art Unit 4114

/James A. Reagan/

Supervisory Patent Examiner, Art Unit 4114